

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

NUTRISHARE, INC., a California
corporation,

Plaintiff,

vs.

BIORx, LLC, an Ohio Limited Liability
Company,

Defendant.

CASE NO. 08 CV 1493 JM (BLM)

ORDER DENYING MOTION FOR
PRELIMINARY INJUNCTION

I. Background

Plaintiff Nutrishare, Inc. (hereinafter “Nutrishare”) brought this action alleging trademark infringement and unfair competition stemming from Defendant BioRx, LLC’s use of its “NutriThrive” mark.¹ Plaintiff filed its complaint in the Eastern District of California on June 4, 2008, and served Defendant on June 26, 2008. Doc. Nos. 1, 12. Based on Defendant BioRx’s motion contesting venue, the case was transferred to the Southern District of California by order entered August 14, 2008. Doc. No. 63. Plaintiff’s motion for preliminary injunction was filed June 24, 2008, and with delays

¹Nutrishare and BioRx (under its NutriThrive label) both provide pharmacy products and services to individuals requiring total parenteral nutrition (“TPN”) in their homes. TPN involves intravenous administration of nutrients to those whose gastrointestinal systems have deteriorated to such a degree they can no longer eat and digest food. Compl. ¶ 1. BioRx also markets products and services in the enteral nutrition area, which involves administration through a tube placed in the nose, stomach or small intestine. Compl. ¶ 1.

1 associated with the transfer of venue, was heard before this court on September 29, 2008. Doc. No.

2 6. Nutrishare seeks a preliminary injunction prohibiting BioRx from:

- 3 • using the name “NutriThrive,” or any variation of the term “nutri,” as a source identifier for
- 4 itself, any related entities, or the products and services it offers;
- 5 • using the domain name www.nutrithrive.com or any other domain name involving the term
- 6 “nutri” or any variation thereof;
- 7 • making any references to the term “NutriThrive” on any websites, including but not limited
- 8 to www.nutrithrive.com, www.biorx.com, and any other websites;
- 9 • causing likelihood of confusion, deception, or mistake as to the source, nature, or quality of
- 10 Defendant’s products and services; or
- 11 • otherwise infringing Nutrishare’s mark.

12

13 **II. Legal Standards for Preliminary Injunction**

14 To prevail on a motion for preliminary injunction, Plaintiff Nutrishare must show: (1) a strong
 15 likelihood of success on the merits; (2) the possibility of irreparable injury if preliminary relief is not
 16 granted; (3) a balance of the hardships favoring Plaintiff; and (4) advancement of the public interest,
 17 where warranted. *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 902 (9th Cir. 2007)(quoting *Earth*
 18 *Island Inst. v. U.S. Forestry Service*, 351 F.3d 1291, 1297 (9th Cir. 2003)). Under the Ninth Circuit’s
 19 alternative test, the court may grant the injunction if Nutrishare demonstrates either: (1) a
 20 combination of probable success on the merits and the possibility of irreparable injury; or (2) serious
 21 questions are raised and the balance of hardships tips sharply in its favor. *Id.*

22

23 **III. Likelihood of Success on the Merits**

24 Nutrishare seeks an injunction based on BioRx’s alleged violation of sections 32(1) and 43(a)
 25 of the Lanham Act. 15 U.S.C. § 1114(1); 15 U.S.C. § 1125(a)(1). To demonstrate a likelihood of
 26 success under either of these statutes, Nutrishare must establish a likelihood of confusion due to
 27 BioRx’s use of a mark that is similar to a valid, protectable trademark of Nutrishare. See *Brookfield*

1 Commc'ns, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 1046 (9th Cir. 1999)(citing AMF
2 Inc. v. Sleekcraft Boats, 599 F.2d 341, 348 (9th Cir. 1979)).

4 **A. “Nutrishare” as a Valid, Protectable Mark**

5 Nutrishare registered its marks on the Principal Register at the USPTO. Pl. Mem. 12:1-2.
6 These registrations constitute *prima facie* evidence of the validity of the marks and of Nutrishare’s
7 exclusive domestic right to use the marks on the goods and services specified in the registration. See
8 15 U.S.C. §§ 1057(b); 1072; 1115(a). BioRx does not dispute the validity of Nutrishare’s trademarks.

10 **B. Likelihood of Confusion**

11 In assessing the likelihood of consumer confusion, the Ninth Circuit looks to the eight
12 Sleekcraft factors to guide its analysis. These factors are: (1) strength of the plaintiff’s mark; (2)
13 relatedness or proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion;
14 (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the
15 purchaser; (7) defendant’s intent in selecting the mark; and (8) likelihood of expansion of the product
16 lines. Sleekcraft, 599 F.2d at 348-49; GoTo.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1205 (9th
17 Cir. 2000). “The confusion must ‘be probable, not simply a possibility.’” Murray v. Cable Nat.
18 Broadcasting Co., 86 F.3d 858 (9th Cir.1996), cert. denied, 519 U.S. 1058 (1997)(quoting Rodeo
19 Collection, Ltd. v. West Seventh, 812 F.2d 1215, 1217 (9th Cir.1987)).

20 *1. Strength of Plaintiff’s Mark*

21 While arbitrary and fanciful marks are “strong,” entitled to maximum protection, descriptive
22 and suggestive marks are considered “weak” and are afforded limited trademark protection.
23 Sleekcraft, 599 F.2d at 349. Nutrishare’s mark qualifies as a suggestive, rather than arbitrary, term
24 for TPN products. Pl. Mem. 16:8-10; Nutri/System, Inc. v. Con-Stan Industries, 809 F.2d 601 (9th Cir.
25 1993)(“nutri” prefix for nutritional products is suggestive). Nutrishare contends its years of
26 advertising and promotion increased the strength of its mark, affording it greater protection. Pl. Mem.
27 16:8-10. However, in Sleekcraft, the court expressly rejected the idea that extensive advertising
28 automatically transforms a suggestive mark into a strong one. Sleekcraft, 599 F.2d at 350.

1 Advertising is just one of many factors relevant to a determination of a mark's overall strength.
2 Nutri/System, 809 F.2d at 605. Given that Nutrishare has been the only exclusive home-based TPN
3 provider for 17 years, and has expended significant time and resources building its unique position
4 in the marketplace, its promotional efforts may have strengthened its mark to some degree. This factor
5 is neutral, favoring neither party.

6
7 *2. Relatedness or Proximity of the Goods*

8 Here, the products and services offered by the parties substantially overlap. Both companies
9 use their trademarks to sell TPN products, services, website support, and educational products, to
10 home-based TPN consumers. This factor favors BioRx.

11
12 *3. Similarity of the Marks*

13 The similarity of marks "has always been considered a critical question in the
14 likelihood-of-confusion analysis." See GoTo.com, 202 F.3d at 1205. Similarity of marks is assessed
15 "in terms of their sight, sound, and meaning." Official Airline Guides, Inc. v. Goss, 6 F.3d 1385, 1392
16 (9th Cir.1993)(citations omitted). Moreover, the "validity and distinctiveness of a composite
17 trademark" is not judged by an examination of its parts, but rather "by viewing the trademark as a
18 whole, as it appears in the marketplace." *Id.*

19 Nevertheless, Nutrishare first parses the marks into components and argues common use of
20 the "nutri" prefix renders the marks confusingly similar. While use of the same "first term of a
21 composite mark fosters confusion, this characteristic alone does not resolve the similarity analysis."
22 Russell v. Caesar, 62 U.S.P.Q.2d 1125, 1129 (N.D. Cal. 2001)("RABBIT RIDGE" and "RABBIT
23 HILL" for wine). The Russell court expressly noted the term "Rabbit" was given greater weight
24 because it is "wholly and uniquely distinctive" when used in connection with wine. *Id.* at 1129 (citing
25 E. & J. Gallo Winery, 782 F.Supp. 457, 464 (N.D.Cal. 1991)). On facts more closely aligned with the
26 present case, the Nutri/System court found "Nutri/System" and "Nutri-Trim" were not confusingly
27 similar, despite their use of the same, *suggestive*, prefix. Nutri/System, 809 F.2d at 605.

As required under *Official Airline*, 6 F.3d at 1392, Nutrishare does address analysis of the marks as a whole, as they are found in the marketplace, but maintains they are still confusingly similar. However, despite the common use of the “nutri” prefix, the marks differ in their overall pronunciations and connotation.² See *Guaber, S.P.A. v. Nutri-metics Int’l, Inc.*, 1991 U.S. App. LEXIS 10842, *3 (Fed. Cir. 1991)(“NEUTROMED” and “NUTRI-METRICS” for personal care products were confusingly similar because of the common prefix plus the marks’ virtually identical pronunciations and confusingly similar connotations). Examination of the actual logos reveals significant differences: Nutrishare’s includes a stylized IV bag and tubing and a person’s face, whereas NutriThrive’s logo employs a different font, a slogan, and an artistic arc of circles connecting the two “i” letters in the company name. Pfister Decl. Ex. B. That the parties use similar terms of art in their ads (“clinical outcomes,” “quality of life”), place ads in the same Oley Foundation newsletter, and target the same customers, are functions of the small and specific area of business the parties have chosen. These contextual issues seem more relevant to the relatedness of goods factor, and should not bear significantly on the similarity of the marks themselves.

Here, the marks used by the parties, viewed as a whole, are not significantly similar. Although it is a close question, this factor favors BioRx.

4. Evidence of Actual Confusion

In support of this factor, Nutrishare presents the declarations of several medical professionals alleging actual confusion already exists in the marketplace. See Okamoto Decl., Nishikawa Decl., Wallin Decl., Stone Decl. In the majority of the offered declarations, reports of confusion are second-hand, and involve medical professionals seeking clarification of the relationship between Nutrishare and NutriThrive. In only one declaration does Nutrishare provide a first-person account which attributes any confusion between the products to the similarity of the company names. Stone Decl. Where parties use an allegedly similar mark in the same market for the same goods, “several dozen inquiries over the years about whether the parties were related,” standing alone, were found to be “too

²The records shows BioRx chose NutriThrive in particular for the “thrive” component’s ability to convey wellness and positive energy. Opp. 4:1-3.

1 ambiguous to demonstrate actual confusion.” *Cohn v. Petsmart, Inc.*, 281 F.3d 837, 842, fn.7 (9th
 2 Cir. 2002); See *Miss World (UK) Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1451 (9th Cir.
 3 1988). Absent further development of the record, this factor is neutral, favoring neither party.

4 5 *5. Marketing Channels Used*

6 The parties use identical marketing channels, including attendance at the Oley Foundation
 7 Conference, sponsorship of the foundation, advertising in the foundation newsletter, maintaining an
 8 interactive website, and in-person meetings with health care professionals. Pl. Mem. 16:22-26. In
 9 such a specialized market, there do not appear to be any alternative marketing channels. However,
 10 since Defendant makes no arguments on this point, the factor weighs in favor of Nutrishare.

11 12 *6. Type of Goods and Degree of Care Exercised by Purchasers*

13 A showing of greater complexity of the goods and sophistication of consumers weighs against
 14 a likelihood of confusion. As specialized, expensive, nutritional products that meet a critical medical
 15 need, the parties’ products are generally purchased with great care. Opp. 14:5-7, 12-13. Regardless
 16 of whether the intended customers are doctors or patients, consumers of such products are generally
 17 experienced buyers who are educated about their conditions, and are therefore more sophisticated than
 18 the average consumer. Opp. 14. This factor weighs in favor of BioRx.

19 20 *7. Defendant’s Intent in Selecting the Mark*

21 Nutrishare strenuously argues BioRx selected “NutriThrive” as its mark intentionally in order
 22 to capitalize on Nutrishare’s goodwill and reputation in the TPN field. Pl. Mem. 17-18. “An intent
 23 to confuse consumers is not required for a finding of trademark infringement.” *Brookfield*, 174 F.3d
 24 at 1059. However, “the presence of intent can constitute strong evidence of confusion.” *Daddy’s*
 25 *Junky Music Stores v. Big Daddy’s Family Music*, 109 F.3d 275, 287 (9th Cir. 1997).

26 According to Nutrishare, BioRx’s adoption of a mark comprising the prefix “nutri,” made with
 27 actual and constructive knowledge of Plaintiff’s mark, constitutes an intent to deceive. *Id.*; Pl. Mem.

1 17:10-18. Such a presumption may be appropriate for an arbitrary or fanciful mark, but it is less so
2 for a weaker mark.

3 Nutrishare points to similarities in the parties' advertising language (which both include terms
4 of art such as "quality of life" and "clinical outcomes"), selection of advertising media (sponsorship
5 of the non-profit Oley Foundation and advertising in its newsletter), and website content ("family"
6 of patients, online forum for patients), as evidence of BioRx's intent. Pl. Mem. 17-18. However,
7 Nutrishare has made no copyright claims, and in such a tight, specialized field, there are limited
8 marketing avenues and terms of art.

9 Finally, from a comparison of the parties' logos and advertisements, BioRx appears to have
10 attempted to distinguish its branding from Nutrishare, within the confines of a specialized medical
11 field. See Pfister Decl. Exh. B; Okamoto Decl. Exh. E. BioRx chose its mark from a pool of fifty
12 possible names, with assistance from a focus group of nutrition professionals, which chose the name
13 based on its connotation of "wellness and positive energy." Opp. 3-4.

14 The evidence on the record fails to show convincingly that BioRx selected NutriThrive to free-
15 ride off Plaintiff's goodwill; therefore, this factor is neutral.

16 17 8. *Likelihood of Expansion of Product Lines*

18 As the parties' product lines already overlap in the TPN field, this factor is less relevant to the
19 likelihood of confusion analysis.

20
21 Based on an analysis of the Sleekcraft factors, Plaintiff fails to demonstrate a strong or
22 probable likelihood of success on the merits.

23 24 **IV. Irreparable Harm**

25 Although "irreparable injury may be presumed from a showing of likelihood of success on the
26 merits of a trademark infringement claim," Nutrishare failed to demonstrate a strong or probable
27 likelihood of success, and is not entitled to the presumption. Brookfield, 174 F.3d at 1066. Nutrishare
28 alleges it will suffer irreparable harm because of: 1) its 15-year investment in the "Nutrishare" name;

1 2) some minor differences in the range of product and services offerings between the two companies;
 2 and 3) unsubstantiated allegations that NutriThrive products are inferior, unaccredited by the
 3 Accreditation Commission for Health Care (ACHC), and potentially dangerous to consumers. Pl.
 4 Mem. 19, 21. On the other hand, BioRx argues Plaintiff's motivation stems not from actual concern
 5 about its reputation, but from NutriThrive's success in an arena Nutrishare once monopolized. Opp.
 6 2. Nutrishare delayed one year after BioRx announced NutriThrive, and six months after the line was
 7 launched to file and serve its complaint, and did not oppose NutriThrive's trademark registration, nor
 8 seek a temporary restraining order. Opp. 16, 18. These facts, while not conclusive, weigh against a
 9 showing of irreparable harm, particularly in light of the exceedingly broad scope of the injunction it
 10 seeks.

11 12 **V. Balance of Hardships**

13 The balance of hardships does not weigh strongly in favor of Nutrishare. Although BioRx may
 14 overstate the effects a preliminary injunction would have on NutriThrive ("BioRx would be required
 15 to shut down NutriThrive, to shut down the ... website, to terminate the employment of seven
 16 employees and one independent contractor ..., and to cease providing its products and services..." Opp.
 17 19:16-19), its new business would be severely impacted. BioRx would face choosing between halting
 18 production and services, and re-branding its newly launched NutriThrive business. Just as Nutrishare
 19 has invested significant time and money over two decades developing its brand, so has NutriThrive,
 20 albeit on a smaller scale, over more than a year's time. Opp. 19:24-25 ("The company has spent more
 21 than \$500,000 to date in developing and promoting NutriThrive."). Plaintiff fails to show money
 22 damages would be an inadequate remedy.

23 24 **VI. Protection of the Public Interest**

25 Nutrishare argued the strong public interest in avoiding confusion in the medical marketplace
 26 warrants imposition of a preliminary injunction. Pl. Mem. 21:2-3. On the other hand, BioRx pointed
 27 out the potential impact an injunction would have on the enteral and TPN patients who rely on its
 28 products. In addition, healthy competition in the market would be stifled. Opp. 20:10-12. As both


1 positions have some merit, the overall effect of the public interest factor on the overall analysis is not
2 substantial.

3
4 **VII. Conclusion**

5 Nutrishare fails to demonstrate a strong or probable likelihood of success on its trademark
6 claims or that it will suffer irreparable harm if a preliminary injunction is not granted. The balance
7 of hardships does not tip strongly in Nutrishare's favor. For these reasons, the court hereby **DENIES**
8 Nutrishare's motion for preliminary injunction (Doc. No. 6).

9 **IT IS SO ORDERED.**

10 DATED: October 23, 2008

11 
12 Hon. Jeffrey T. Miller
United States District Judge

13 cc: All parties
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